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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,785	02/11/2004	Ronald D. Ringleben	NAC/ 124US	3249
26875	7590	03/27/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			ROSSI, JESSICA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,785

Applicant(s)

RINGLEBEN ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 7, 8, 12, 13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6, 9-11 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/4/04, 5/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species Group I

Species A (appears to be claims 1-5), drawn to dispensing the adhesive as shown in Figures 7-10.

Species B (appears to be claims 6-14), drawn to transferring the adhesive as shown in Figures 6A-6C and Figures 11-14.

Species C (appears to be claims 10, 15), drawn to screen printing the adhesive as shown in Figure 15.

Species Group II (only necessary if Applicant elects Species B from Group I)

Species Bi (appears to be claims 7, 10-12), drawn to transfer printing the adhesive as shown in Figures 6A-6C.

Species Bii (appears to be claims 8, 10-11, 13), drawn to pad printing the adhesive as shown in Figures 13-14.

Species Biii (appears to be claims 9-11 and 14), drawn to flexographic printing the adhesive as shown in Figures 11-12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. During a telephone conversation with Mr. Allen on 3/16/06 a provisional election was made without traverse to prosecute the invention of Species B and Biii, claims 6, 9-11 and 14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5, 7-8, 12-13 and 15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 9, it recites the limitation "the resilient printing block" in lines 6-7 and lines 8-9. There is insufficient antecedent basis for this limitation in the claim. It appears Applicant has mixed Species Biii (printing plate) with Species Bi (printing block, see claim 7). It is suggested to change "block" to --plate--.

Regarding claim 14, it recites the limitation "the resilient printing block" in lines 6-7 and lines 8-9. There is insufficient antecedent basis for this limitation in the claim. It appears Applicant has mixed Species Biii (printing plate) with Species Bi (printing block, see claim 7). It is suggested to change "block" to --plate--.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claim 6 is rejected under 35 U.S.C. 102(a) as being anticipated by Barth et al. (US 6682702).

With respect to claim 6, the reference is directed to a method of making a multi-well test plate including a transparent panel 113 (Figures 2-3; column 11, lines 56-58; column 13, lines 53-62; column 3, lines 51-55) and an upper frame portion 101 with a plurality of walls 103 defining wells 104 arranged in a pattern (Figures 2-3; column 11, lines 36-41 – note gasket 121/131 can be integral with the plate; column 18, lines 8-10). The reference teaches transferring an adhesive arranged in a configuration corresponding to the pattern from a transfer member to the upper frame portion (column 18, lines 26-34; column 12, lines 43-46 – note

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adhesive can be applied to transparent panel and/or frame portion), contacting the transparent panel with the upper frame portion such that the adhesive is disposed between the transparent panel and the upper frame portion and curing the adhesive to bond the upper frame portion and transparent panel (column 12, lines 52-58).

8. Claim 6 is rejected under 35 U.S.C. 102(a) as being anticipated by Tanner et al. (US 2003/0031829, listed in IDS).

**It is noted that the present invention is directed to bonding the transparent panel to the bottom surface of the upper frame portion even though the present claims are not limited to such. However, the following rejection is set forth to expedite prosecution.*

With respect to claim 6, the reference is directed to a method of making a multi-well test plate including a transparent panel 22 (Figures 1-3; section [0019]) and an upper frame portion 20 with a plurality of walls 24 defining wells 16 arranged in a pattern (Figures 1-3; section [0017] and last sentence in section [0023]). The reference teaches transferring an adhesive 28 arranged in a configuration corresponding to the pattern (note adhesive 28 not located along bottom walls 26 within wells 16 as clearly shown in Figure 2) from a transfer member to the upper frame portion (Figure 5; last sentence in section [0070] - [0071]), contacting the transparent panel with the upper frame portion such that the adhesive is disposed between the transparent panel and the upper frame portion and curing the adhesive to bond the upper frame portion and transparent panel (sections [0026] and [0071]).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barth et al. as applied to claim 6 above and further in view of Razavi (US 2004/0032093, listed in IDS).

Regarding claim 10, it is unclear as to whether Barth teaches the adhesive transfer technique being flexographic printing (column 12, lines 43-46). One reading the reference as a whole would have appreciated that a particular technique for transferring the adhesive is not critical to the invention and selection of a particular technique would have been within purview of one of ordinary skill in the art. However, it would have been obvious to one of ordinary skill in the art to use flexographic printing to transfer the adhesive pattern to the frame portion of Barth because such an adhesive transfer technique is known in the multi-well test plate art as an alternative to a variety of other adhesive transfer techniques for transferring an adhesive to a substrate wherein the adhesive is arranged in a configuration corresponding to the pattern defined by the walls that form the wells in a frame portion, as taught by Razavi (sections [0002, 0006, 0015, 0016]).

Regarding claim 11, all the limitations were addressed above with respect to claims 6 and 10 except transferring the adhesive to the transparent panel. Barth teaches the adhesive being transferred to the frame portion and/or transparent panel (column 18, lines 26-30).

11. Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barth et al. and Razavi as applied to claims 6 and 11 above, and further in view of Jordan et al. (US 6655281).

Regarding claims 9 and 14, one of ordinary skill in the art would have readily appreciated that a basic flexographic printing system comprising a rotating drum carrying a resilient printing plate on its exterior surface wherein the plate has raised lines corresponding to the desired adhesive pattern to be transferred to a substrate is well known and conventional, as evidenced by Jordan (Figure 1A; column 4, lines 53-61).

12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al. as applied to claim 6 above and further in view of Razavi.

Regarding claim 10, it is unclear as to whether Tanner teaches the adhesive transfer technique being flexographic printing (section [0071]). One reading the reference as a whole would have appreciated that a particular technique for transferring the adhesive is not critical to the invention and selection of a particular technique would have been within purview of one of ordinary skill in the art. However, it would have been obvious to one of ordinary skill in the art to use flexographic printing to transfer the adhesive pattern to the frame portion of Tanner because such an adhesive transfer technique is known in the multi-well test plate art as an alternative to a variety of other adhesive transfer techniques for transferring an adhesive to a substrate wherein the adhesive is arranged in a configuration corresponding to the pattern defined by the walls that form the wells in a frame portion, as taught by Razavi (sections [0002, 0006, 0015, 0016]).

Regarding claim 11, all the limitations were addressed above with respect to claims 6 and 10 except transferring the adhesive to the transparent panel. Tanner teaches the adhesive being transferred to the frame portion or transparent panel (section [0071]).

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13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al. and Razavi as applied to claim 6 above, and further in view of Jordan et al.

Regarding claim 9, one of ordinary skill in the art would have readily appreciated that a basic flexographic printing system comprising a rotating drum carrying a resilient printing plate on its exterior surface wherein the plate has raised lines corresponding to the desired adhesive pattern to be transferred to a substrate is well known and conventional, as evidenced by Jordan (Figure 1A; column 4, lines 53-61).

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al., Razavi and Jordan et al. as applied to claims 9 and 11 above, and further in view of Barth et al.

Regarding claim 14, all the limitations were addressed above with respect to claims 9 and 11, except transferring the adhesive to the upper frame portion in addition to the transparent panel (note claim 11 transfers adhesive to the transparent panel). Tanner teaches the adhesive being transferred to the frame portion or transparent panel (section [0071]); therefore, it would have been obvious to transfer the adhesive to both the transparent panel and the frame portion because such is known in the art, as taught by Barth (column 18, lines 26-29).

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over Khan et al. (US 2004/0020595, listed in IDS) in view of Razavi.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

With respect to claim 11, Khan teaches all the limitations (transparent panel 20, upper frame portion 12, adhesive 22, screen printing transfer member 30 transfers adhesive to panel 20 - abstract; sections [0018-0022]) except the adhesive transfer method being flexographic printing. It would have been obvious to one of ordinary skill in the art to use flexographic printing as an alternative to the screen printing of Khan because such an adhesive transfer technique is known in the multi-well test plate art as an alternative to a variety of other adhesive transfer techniques, including screen printing, for transferring an adhesive to a transparent substrate wherein the adhesive is arranged in a configuration corresponding to the pattern defined by the walls that form the wells in a frame portion that is subsequently bonded to the transparent substrate, as taught by Razavi (sections [0002, 0006, 0015, 0016]).

16. Claims 6, 9-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al. and Razavi as applied to claim 11 above, and further in view of Jordan et al. and the collective teachings of Barth et al. and Tanner et al.

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Regarding claim 14, one of ordinary skill in the art would have readily appreciated that a basic flexographic printing system comprising a rotating drum carrying a resilient printing plate on its exterior surface wherein the plate has raised lines corresponding to the desired adhesive pattern to be transferred to a substrate is well known and conventional, as evidenced by Jordan (Figure 1A; column 4, lines 53-61).

As for transferring the adhesive to upper frame portion, it would have been obvious in addition to or as an alternative to transferring the adhesive to the transparent panel because such is known in the art as taught by the collective teachings of Barth (column 18, lines 26-29) and Tanner (section [0071]).

With respect to claims 6 and 9-10, all the limitations were addressed with respect to claims 11 and 14.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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18. Claim 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 7,005,029 (issued from PGPUB 2004/0020595 to Khan et al.) in view of Razavi.

Applicant is invited to reread the rejection set forth in paragraph 15.

19. Claims 6, 9-10 and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 7,005,029 (issued from PGPUB 2004/0020595 to Khan et al.) in view of Razavi, as applied to claim 11 above, and further in view of Jordan et al. and the collective teachings of Barth et al. and Tanner et al.

Applicant is invited to reread the rejection set forth in paragraph 16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JESSICA ROSSI
PRIMARY EXAMINER

Jessica Rossi